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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		35399.4	
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<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>40,013</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>		<p><u>[Signature]</u> Signature James E. Harris Typed or printed name</p> <p><u>512-867-8502</u> Telephone number</p> <p><u>9/21/05</u> Date</p>	
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input type="checkbox"/> *Total of <u>one</u> forms are submitted.</p>			

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PATENT APPLICATION
Do. No. 35399.4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Shivi Fotedar

Serial No. 09/837,896

Examiner: Kevin D. Mew

Confirmation No. 8334

Filed: April 18, 2001

Group Art Unit: 2664

For: **METHOD AND APPARATUS FOR UPDATING ADDRESSES IN NETWORK
PROCESSING DEVICE**

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Responsive to the Final Office Action, dated July 21, 2005, please consider the following remarks in connection with the pre-appeal brief request for review. Review of the final rejection is requested for the following reasons.

1. The Rejection Of Claim 1 And Its Dependent Claims Is Not Supported By A *Prima Facie* Case Of Obviousness For Claim 1

Claim 1 and its dependent claims 2-7 were rejected under 35 U.S.C. § 103(a) as obvious in view of Rao (US Patent No. 6,789,118). A *prima facie* case of obviousness is missing, however, at least because Rao fails to disclose each element of the claim or suggest the missing elements.

The rejection admits, regarding claim 1, that "Rao does not explicitly show the packet processing circuitry adapted to multicast the address reply to multiple ones of the processors at the same time." (Paper No. 7 at 3.) The rejection argues, however, that Rao's device has multicast circuitry capable of moving user traffic between its forwarding modules and an IP cache in each forwarding module for holding a list of the most recent IP source/destination pairs and port addresses. (*Id.*)

The assertion that Rao has a mechanism for multicasting traffic and a mechanism for holding recent IP address information at each forwarding module, even if correct, is insufficient to show that Rao teaches or suggests packet processing circuitry as claimed. Rao's explicit teaching is that address reply messages are unicast back to the requester. (See Paper No. 6 at 6, last two paragraphs.) There is no suggestion in Rao to multicast the reply to non-requesters (Applicant notes that the Examiner presents a motivation, spanning pages 3 to 4 of Paper No. 7, that is not identified as being taken from any prior art teaching). And the IP cache has no apparent relevance at all, as it only relates to recent traffic handled by each specific card and not to address replies, which has a separate table. (Rao, col. 12, ll. 15-37, Figs. 7-8.) Thus the rejection fails to show any prior art teaching or suggestion for the claimed packet processing circuitry "to multicast [a received] address reply to multiple ones of the processors at the same time," and is therefore insufficient to create a *prima facie* case of obviousness.

Other reasons for the patentability of claims 1-7 have been previously presented and will be maintained should the filing of an appeal brief become necessary.

2. The Rejection Of Claim 8 And Its Dependent Claims Is Not Supported By A *Prima Facie* Case Of Obviousness For Claim 8

Method claim 8 and its dependent claims 9-14 were rejected under 35 U.S.C. § 103(a) as obvious in view of Rao. A *prima facie* case of obviousness is missing, however, at least because Rao fails to disclose each element of the claim or suggest the missing elements.

The rejection presents the same argument, with the same deficiencies, as noted above, for the claim 8 element "broadcasting the address reply to multiple ones of the applications or processors at the same time." (Paper No. 7 at 7.) Applicant respectfully refers the review panel to the response given in item 1 above.

A second error in the *prima facie* case for claim 8 lies in an application of Rao to the claims that relies on an unreasonable claim construction. Claim 8 requires, in part, (a) receiving an address request from one or more of the applications or processors, (b) sending the address request over a network, (c) receiving an address reply from the network, and (d) broadcasting the address reply to multiple ones of the applications or processors at the same time. (Paper No. 6 at 4, identifiers (a-d) have been added to allow reference below.) The rejection applies Rao such that the "network" connects the "applications or processors", elements (a) and (b) identified above are the sending and receiving ends of the same transaction, and elements (c) and (d) above are the sending and receiving ends of the same

transaction. (Paper No. 7 at 6-7.) This position is clearly untenable, based on the plain language of the claim—the address request must be received from an application or processor before it can be sent over the network, and the address reply must be received back from the network before it can be broadcast to multiple ones of the applications or processors. The rejection has applied this strained construction presumably because without it Rao's internal management ARP process is even further from what is claimed.

Applicant also notes that in the remarks section of Paper No. 7 (page 14), the Examiner erroneously applies this incorrect construction to claim 1 as well, although clearly the network is external to the network processing device in claim 1.

Other reasons for the patentability of claims 8-14 have been previously presented and will be maintained should the filing of an appeal brief become necessary.

3. The Rejection Of Claim 15 And Its Dependent Claims Is Not Supported By A *Prima Facie* Case Of Obviousness For Claim 15

Claim 15 and its dependent claims 16-19 were rejected under 35 U.S.C. § 103(a) as obvious in view of Rao. A *prima facie* case of obviousness is missing, however, at least because Rao fails to disclose each element of the claim or suggest the missing elements.

Claim 15 recites multiple processors for controlling operations in a network processing device, and packet processing circuitry adapted to detect unicast control packets from a network and convert the unicast packets into multicast control packets that are relayed in parallel to the multiple processors at the same time. To establish a *prima facie* case of obviousness, then, the prior art must teach packet processing circuitry that detects unicast control packets from a network and converts these packets into multicast control packets for relay to multiple processors.

Rao's disclosed multicast groups appear to be used for packets directed to multicast or broadcast addresses. The Examiner has identified no teaching in Rao of packet processing circuitry that detects unicast control packets from a network and converts the unicast control packets to multicast control packets.

The Examiner has pointed to an internal capability in Rao to send multicast packets to multicast groups across a backplane, (Rao, col. 29, ll. 13-19), even though this ignores the claim 15 limitation that the packets are "unicast control packets from a network". It is clear that the Examiner attributes to this section of Rao several elements of the claim that Rao does not teach. (Paper No. 6 at 14.) For instance, this section of Rao discloses "[w]hen the packet is sent to a multicast group, the packet is sent to the backplane." (Rao, col. 29, ll. 15-16.)

The Examiner reframes this step as “receiving a unicast packet to GFI backplane.” (Paper No. 6 at 14, l. 14.) But clearly a packet sent to a multicast group is not a unicast packet. And distributing a multicast packet to multiple ports, as asserted by the Examiner, is not converting a detected unicast packet to multicast as claimed.

Other reasons for the patentability of claims 15-19 have been previously presented and will be maintained should the filing of an appeal brief become necessary.